

## **REMARKS**

### **Introduction**

The above amendments and these remarks are responsive to the Office action dated February 12, 2007. Claims 1-3 and 5-20 are pending in the application. Claims 1-3 and 5-20 are rejected. In view of the following remarks, Applicants respectfully request reconsideration of the claims under 37 C.F.R. § 1.111.

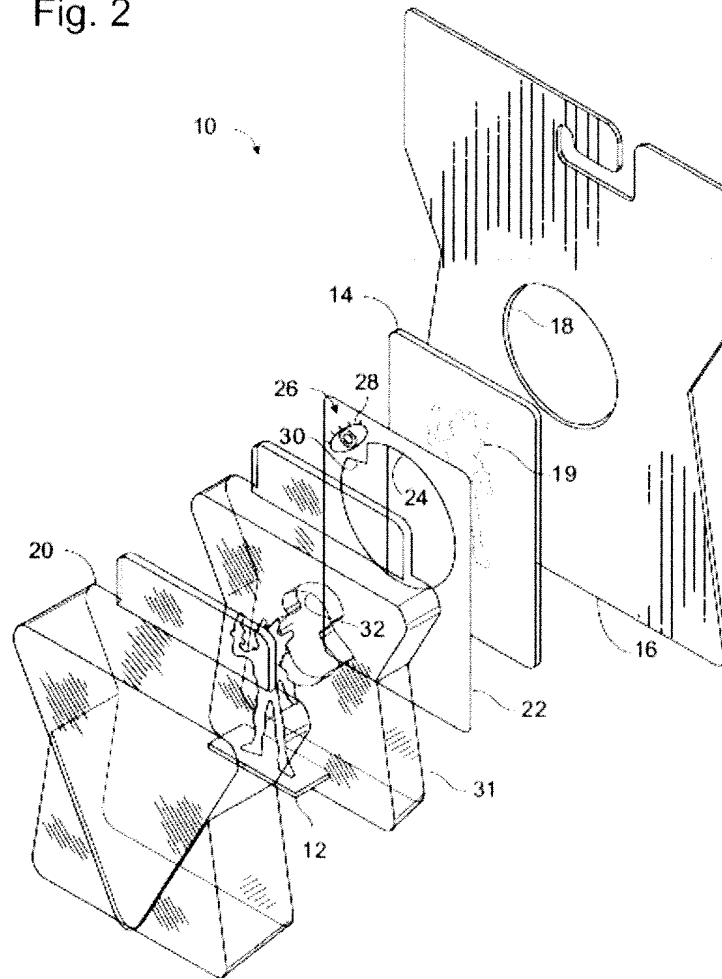
### **Objections to the Drawings**

The drawings are objected to under 37 C.F.R. § 1.83(a) as allegedly failing to show every feature of the invention specified in the claims. In particular, the Examiner suggests that the lithophane support blister must be shown in the drawings or canceled from the claims. Applicants respectfully disagree that corrected drawings are required.

The Applicants note that the specification indicates that while "support blister 31 is omitted from Fig. 1 for clarity," it also indicates that "toy packaging 10 may also include a support blister 31, as shown in Fig. 2" (see the specification at paragraph 0022, lines 1-2). Figure 2 of the application is reproduced below. Support blister 31 is shown interposed between toy 12 and cover sheet 22.

As the drawings accompanying the application show every feature of the invention specified in the claims, Applicants suggest that the drawings are in compliance with 37 C.F.R. § 1.83(a), and that the Examiner's objection is improper. Applicants therefore respectfully request the withdrawal of the objection to the drawings.

Fig. 2



***Rejections under 35 U.S.C. § 103 over Dods '298, Lapides, and Goldfarb '492***

Claims 1-3, 5-10, 12-16, and 18-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Dods (U.S. Patent no. 6,152,298; hereafter Dods '298), Lapides (U.S. Patent no. 3,173,540), and Goldfarb et al. (U.S. Patent no. 6,287,492; hereafter Goldfarb '492). In particular, the Examiner alleges that it would have been obvious to one of ordinary skill in the art from the teaching of Lapides to include an aperture in the backing sheet of Dods '298 in order to not hinder a potential purchaser's view of the item while still in the packaging. Furthermore, the Examiner alleges it would have been obvious to one of ordinary skill in the art from the teaching

of Goldfarb to modify the panel of Dods '298 to incorporate a lithophane-type panel in order to create a visually interesting display. Applicants respectfully disagree, and suggest that the Examiner has failed to establish the *prima facie* obviousness of the claimed invention.

The rejected claims are directed to packaged toys and toy sets that include lithophanes. Independent claim 1 is directed to a packaged toy set, including a toy figure depicting a character and a lithophane panel depicting an image, where the toy set is packaged so that both the toy figure and the lithophane panel are visible, and the depicted image may be viewed when backlit.

Independent claim 5 is directed to a packaged toy, including a backing sheet having at least one aperture, a toy associated with the backing sheet, and a lithophane panel associated with the backing sheet, where at least a portion of the image depicted by the lithophane panel is aligned with the aperture and viewable when backlit.

Independent claim 18 is directed to a packaged toy that includes a planar backing sheet having at least one aperture, a toy figure, a lithophane panel, a substantially transparent cover blister that is attached to the backing sheet that at least substantially encloses the figure and the lithophane panel, and a support blister disposed between the cover blister and the backing sheet configured to support at least one of the figure and the lithophane panel, where at least a portion of the image depicted by the lithophane panel is aligned with the aperture and viewable when backlit.

#### Dods '298

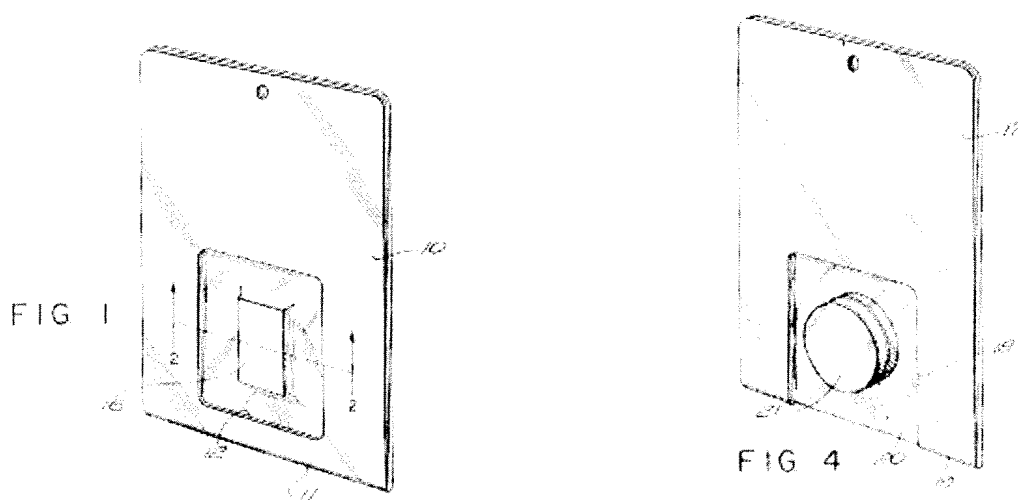
The Dods '298 reference discloses a system of display packaging suited for the display of trading cards, typically in combination with a vehicle model. For example, "This invention generally relates to display packaging of trading cards, alone or in combination with models" (col. 1, lines 5-6); "this invention is a package system to display a combination including at least

a trading card and a model..." (col. 2, lines 54-55); and "in part, this invention is a package system for displaying a trading card and model combination" (col. 2, lines 61-62). Although the package system of Dods '298 may include a model, such as a vehicle model, the disclosure explicitly requires the display of a trading card.

The trading card of Dods '298 has a front face and a rear face (col. 2, lines 61-65), each of which can display information, text, graphics or pictorials (col. 5, lines 53-56). The trading card of Dods '298 is distinct from a translucent lithophane pane.

### *Lapides*

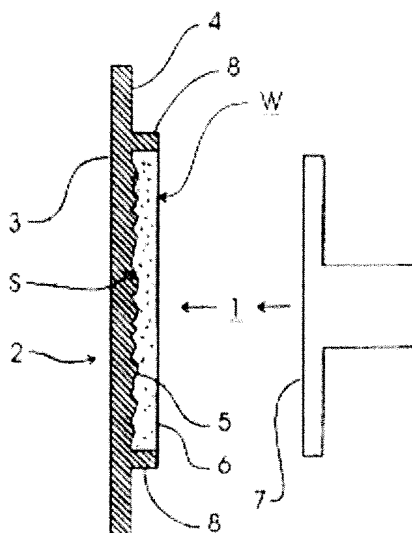
The Lapides reference discloses a display package that incorporates one or more windows made with a heat-shrinkable film. In use, a small package or article is positioned so that when the packaging is folded, the article is clamped between two sheets of the shrinkable film. The film may then be heated to wrap tightly around the article (see col. 2, lines 24-35). Examples of articles packaged in this manner may be found in Fig. 1 and Fig. 4 of Lapides (shown below):



The reference characterizes the article packaged thereby as only "a stock item which can be readily available to small users at a reasonable cost" (col. 3, lines 6-8). There is no suggestion in Lapides to utilize the disclosed packaging system for any particular item.

*Goldfarb '492*

The Goldfarb '492 reference is directed to an apparatus for producing temporary lithophane-like works from a translucent and pliable material, such as PLAY-DOH modeling clay (see col. 3, line 66 to col. 4, line 20; and col. 6, lines 1-6). The thin panels are formed by pressing the translucent and pliable material against a contoured surface S of the apparatus, where the surface features a negative, or "reverse image" of the desired lithophane contour on a "forming surface" 5, as shown below in Fig. 4 of Goldfarb '492:



It's important to note that the forming apparatus of Goldfarb '492 is not a lithophane itself, since it is either completely transparent (at col. 4, lines 39-44) or it is opaque. However, even if the forming apparatus itself *were* translucent, backlighting the Goldfarb apparatus could not form the desired lithophane image, but would instead display the negative or "reverse image" of the desired lithophane (see col. 2, lines 19-23). Where Goldfarb '492 describes a formed lithophane work, it is understood to be a temporary and freshly made sheet formed from a pliable material that is easily further deformed.

### Discussion

The Examiner suggests it would have been obvious to include an aperture in the backing sheet of Dods '298 in order to not hinder a potential purchaser's view of the item while still in the packaging. Applicants note that the technology of Lapidés had been available to the public for more than forty years at the time Dods '298 was filed, and that if it had been both economical and desirable to do so, Dods would have disclosed the incorporation of such an aperture in their packaging. The concept of showing both the front and back of a packaged object is not a new one.

Applicants are claiming packaged toys that include both a toy and a lithophane panel depicting an image, where the toy and lithophane are packaged so that the lithophane image may be viewed through the packaging, advantageously permitting a prospective purchaser to view at least a portion of the image produced by the lithophane panel.

Lapidés is silent on the packaging of toy sets, describing only the packaging of single articles, and provides no disclosure of lithophanes whatsoever. Dods '298 requires that their disclosed packaging includes a trading card, with an optional inclusion of a model, and similarly fails to disclose the packaging of any lithophane, or the desirability of doing so. The Examiner has suggested that Goldfarb '492 provides an incentive to formulate the claimed toy sets, including inclusion of a lithophane panel. Applicants suggest that the disclosed lithophane works of Goldfarb are disclosed as suitable for inclusion in a packaged toy, nor is such a packaged toy described as desirable, for at least the following reasons.

The apparatus of Goldfarb et al., cannot itself be utilized as a lithophane, as it incorporates a reversed image and is not suitable for forming the desired image. In any event, the apparatus itself is disclosed as either transparent or opaque, and therefore cannot form the

translucent image required for a lithophane panel.

The lithophane works that may be formed using the Goldfarb apparatus are not themselves suitable for being packaged, displayed, and sold. The disclosed lithophane works are pliable, easily deformed, and temporary. For example Goldfarb recommends the use of PLAY-DOH modeling compound in conjunction with the disclosed lithophane-forming apparatus, as PLAY-DOH modeling compound produces "very good pictures" at "a maximum thickness of about one-eighth of an inch or less" (see col. 6, lines 4-6). Applicants respectfully suggest Goldfarb et al. provide no suggestion or motivation to package a sheet of PLAY-DOH compound one-eighth of an inch thick (or less!) to accompany a toy, much less motivation to combine the thin and pliable sheet with the packaging of Lapides or Dods '298.

The Examiner points to the character of Fig. 20 of Goldfarb et al., reproduced below, indicating that it provides "a lithophane-type panel (903) that can be attached to a toy figure ... to create interesting visual displays when backlit", and that "rearrangement of the location and position of the plate is not a patentable advance".

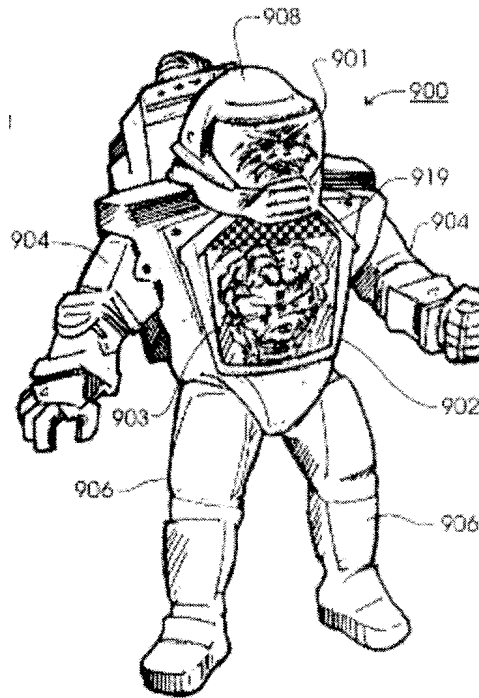


FIG. 20

Applicants note that the lithophane works of figure 900 of Fig. 20 of Goldfarb et al. are also disclosed as formed from a soft and pliable substrate. Figure 900 is described as permitting a variety of these temporary lithophane works to be mounted on the toy figure during play in order to provide an alterable face, or a variety of views on display 903. Applicants suggest that this mode of play using the toy figure of Figure 20 fails to provide a motivation to one of ordinary skill to package the toy figure with a fixed lithophane work as if for sale.

In order to establish a case of *prima facie* obviousness, there must be some suggestion or motivation in the prior art itself to modify the references or combine the reference teachings. The Examiner asserts that the cited references provide motivation "to create a visually interesting display" by modifying the panel of Dods '298 to make it a lithophane-type panel. Applicants can find no explicit suggestion that modification of Dods '298 in this way would be advantageous, or create a visually interesting display, or that the display of Dods '298 is in any way lacking in



presentation and therefore required improvement. Applicants suggest that the Examiner is merely stating advantages possessed by the instant invention, which does not constitute the identification of a motivation found in the prior art to make the modifications necessary to arrive at the invention.

If anything, the Examiner's suggested motivation to combine is a statement that predicts a *possible* result of making the combination, rather than a motivation to combine the references. Such a statement corresponds to an acknowledgement that the references *can* be combined. However, even a proven statement that references can be combined or modified does not render the resultant combination obvious unless the prior art *also* suggests the desirability of the combination (In re Mills, 916 F.2d 680 (Fed. Cir. 1990); MPEP §2143.01).

As the Dods '298 reference fails to discuss the inclusion of anything resembling a lithophane panel, but *requires* the inclusion of a trading card, with information printed on the front and rear surfaces, Applicants suggest that modifying the invention of Dods '298 to arrive at the claimed toy set of claim 1 would render the trading card packaging system of Dods '298 unsatisfactory for its intended purpose. Therefore, there can be no motivation or suggestion to modify Dods '298 as suggested by the Examiner (MPEP § 2143.01).

Goldfarb et al. fail to disclose any packaging for their lithophane activity apparatus, but more importantly, they fail to disclose any packaging for the thin, pliable, and temporary lithophane works produced using the disclosed apparatus. Applicants suggest that the Goldfarb et al. reference is directed to apparatus for the *preparation* of lithophane works, and their use in play, not the display of lithophane panels as a component of toy packaging. Modifying the teaching of Goldfarb et al. as suggested by the Examiner would change the principle of operation of the Goldfarb et al. apparatus. Therefore, there can be no motivation or suggestion to modify

Goldfarb '492 as suggested by the Examiner (MPEP § 2143.01)

In the absence of a motivation or suggestion to combine the references, there can be no *prima facie* obviousness. In view of the above remarks, Applicants therefore suggest that the invention of claims 1, 5, and 18 are not rendered obvious by the combination of Dods '298, Lapides, and Goldfarb et al. '492.

As claims 2, 3, 6-10, 12-16, 19, and 20 depend from independent claims 1, 5, and 18, Applicants suggest they are similarly not rendered obvious by the combination of the cited references.

Claim 11 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Dods '298, Lapides, and Goldfarb '492. The Examiner suggests that it would have been obvious to one of ordinary skill in the art to multiply the number of toys and panels, since such a modification would have involved a mere duplication of parts.

As discussed above, Applicants respectfully suggest that the Dods, Lapides, and Goldfarb references, singly or in combination, fail to render the invention of claim 5 obvious. Applicants therefore suggest that dependent claim 10 is similarly not rendered obvious by the cited references.

**Rejection under 35 U.S.C. § 103 over Dods '298, Lapides, Goldfarb '492, and Mickelberg**

Claim 17 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Dods '298, Lapides, Goldfarb '492, and Mickelberg (U.S. Patent no. 5,289,916). The Examiner suggests that the cited references disclose the basic inventive concept, substantially as claimed, with the exception of having an indication that the panel is viewable when backlit. The Examiner further suggests that Mickelberg provides a packaged toy having instructions or indicia on the packaging to alert a person to features available from the toy while still packaged.

Applicants suggest that claim 17 is directed to more than merely an indicia that alerts a person to a feature available from the toy. Claim 17 is directed to a packaged toy having an indication that the lithophane panel contained therein includes an image that is viewable through the packaging when backlit.

Applicants appreciate that the packaging disclosed by the Mickelberg reference includes apertures. However, the toy depicted by Mickelberg is in no way translucent, and a viewer would obtain no benefit from viewing the toy of Mickelberg when backlit.

Furthermore, in view of the above remarks, Applicants suggest that the Dods '298, Lapides, and Goldfarb '492 references, singly or in combination, fail to render the invention of claim 5 obvious. Applicants therefore suggest that even in combination with the Mickelberg reference, the subject matter of dependent claim 17 is similarly not rendered obvious by the cited references.

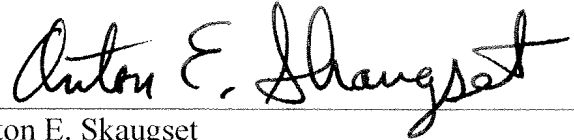
In view of the above remarks, Applicants respectfully request the withdrawal of the rejections of claims 1-3, and 5-20 under 35 U.S.C. § 103.

**Conclusion**

Applicants believe that the instant application is in condition for allowance. However, if the Examiner has any questions, or if a telephone interview would in any way advance prosecution of the application, please contact the undersigned agent of record.

Respectfully submitted,

KOLISCH HARTWELL, P.C.

A handwritten signature in black ink, reading "Anton E. Skaugset". The signature is written in a cursive style with a horizontal line underneath it.

Anton E. Skaugset

Registration No. 38,617

Customer No. 23581

Attorney/Agent for Applicant(s)/Assignee

520 S.W. Yamhill Street, Suite 200

Portland, Oregon 97204

Telephone: (503) 224-6655

Facsimile: (503) 295-6679